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09/684,057	10/06/2000	Stefan Johansson	15292.2	1607

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EXAMINER

REILLY, SEAN M

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,057

Applicant(s)

JOHANSSON, STEFAN

Examiner

Sean Reilly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 18, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 35-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to Applicant's amendment and request for reconsideration filed on May 18, 2006. Claims 1-30 and 35-44 are presented for further examination. All independent claims have been amended. Claims 31-34 are withdrawn from consideration.

Response to Arguments

1. In response to Applicant's request for reconsideration filed on May 18, 2006, the following factual arguments are noted:

- a. Winbladh failed to disclose performing the claimed features in a stand-alone mobile communication station.
- b. There is no motivation to combine GPRS functionality in Winbladh's system.
- c. Winbladh's system only uses an activation code during registration and not during the examining act as claimed.
- d. Winbladh failed to disclose a service field is used to generate a message describing a service that is about to be initiated.

In considering (a), Examiner respectfully disagrees with Applicant's argument. Winbladh disclosed "in the future, when a mobile station can be expected to consist of a computer hybrid, the SMS agent decoding functions may be included in the MS unit" (mobile unit) (Winbladh Col 5, lines 8-11). Clearly this amounts to an explicit disclosure that the mobile communication station may act in a stand-alone capacity. Furthermore, even if one were to

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argue persuasively that this disclosure does not meet the 102 anticipation standard then Examiner maintains that such a modification would have certainly been obvious in view of this discussion.

In considering (b), Examiner respectfully disagrees with Applicant's argument.

Applicant contends that it would not be obvious to modify Winbladh's system to utilize GPRS communication. Examiner disagrees. Applicant states that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant case, motivation comes clearly from both the Winbladh system and the Lager system. As stated in the previous office action Winbladh disclosed that his system is not restricted to any specific wireless telephone system or protocol such as GSM and that other telecommunications systems can be used within the system (Col 3, lines 38-48). Thus, one of ordinary skill in the art would have been motivated to seek out and use other known wireless protocols within Winbladh's system. As evidenced by both by Lager and Applicant's admitted prior art (Specification pg 1) the use of the GPRS protocol in a wireless environment was widely known in the art at the time of Applicant's invention. Thus, it would have been obvious to one of ordinary skill in the art to utilize GPRS in Winbladh's system since it is a protocol capable of transferring data between nodes in a wireless environment. Further, GPRS provides for effective use of scarce resources (see Lager, col. 1, lines 22-26). Applicant certainly did not invent GPRS

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or the use of GPRS in a communication network (see Applicant's admission in the specification pg 1). Furthermore Examiner traverses Applicant's argument that it is not clear whether GPRS would provide a more effective use of resources than the system setup in Winbladh and thus there is no clear motivation to combine the two. As explicitly stated by Lager, GPRS provides for the efficient use of scarce resources (Col 1, lines 22-26). This point taken alone provides a clear motivation to one of ordinary skill in the art to utilize GPRS in Winbladh's system.

In considering (c), Examiner respectfully disagrees with Applicant's argument. Winbladh's system clearly continues to use the activation code for all future communications ("which *thereafter is the method* by which e-mail is sent and received by a user registered in the user database," emphasis added, Col 8, lines 53-61).

In considering (d), Examiner respectfully disagrees with Applicant's argument. Winbladh disclosed the use of a prefix to generate a list of possible commands (Col 7, lines 37-60). The claimed service field is analogous to Winbladh's prefix and the claimed message describing a service that is about to be initiated is analogous to Winbladh's commands displayed to the user (e.g. Get Now).

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on June 19, 2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 1-30 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winbladh (U.S. Patent No. 6,205,330) and Lager et al. (U.S. Patent No. 6,636,502, hereinafter "Lager").**

In considering claims 1, 5, 20, 26, 29, 35, and 36 Winbladh discloses a method for initiating immediate transfer of packet data from a network server ("server 11") to a mobile communication station ("MS unit 20" coupled to "PC 22") over a digital radio communication network ("GSM" network, col. 7, lines 3-8; col. 3, lines 50-52), including the acts of:

Sending a message to the mobile communication station using a message service provided by the digital radio communication network ("SMS [message] is sent to the MS unit 20, "col. 7, lines 6-8), said message including a first data network address of said network server (col. 7, lines 7-8, 32-35, "SMS message is comprised of... a field 'DSG address (Data SMS Gateway Address)' containing the address and/or telephone number of the server 11 in which the intended e-mail has been stored");

Extracting the first data network address from the message by way of an application executing on the mobile communication station (col. 7, lines 58-61, "the communications

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software 46 reads the agent-part 48 of SMS and... calls the number in the 'DSG address,'" wherein the "DSG" address is the address of the server, col. 7, lines 31-35); and

Establishing, by the application of the mobile communication station having a second data network address (the computer unit 22 necessarily has a second data network address to set up the session), a data protocol session between said mobile communication station and said network server using said first data network address (col. 7, lines 61-62, "calls the number in the 'DSG address' 47 (start of a session)");

Whereby the network server is able to transfer data to the mobile communication station and the application using said data protocol session (col. 7, lines 63-67, "[server 11] commences the transmission of data in the same session").

With regard to the stand-alone device limitations, Winbladh disclosed "in the future, when a mobile station can be expected to consist of a computer hybrid, the SMS agent decoding functions may be included in the MS unit" (mobile unit) (Winbladh Col 5, lines 8-11). Clearly this amounts to an explicit disclosure that the mobile communication station may act in a stand-alone capacity. Furthermore, even if one were to argue persuasively that this disclosure does not meet the 102 anticipation standard then Examiner maintains that such a modification would have certainly been obvious in view the explicit motivation in Winbladh and further since such a configuration would not require the use of an additionally PC for processing and thus allow the mobile device to receive email from anywhere wireless communications are available.

Winbladh failed to specifically recite the digital radio communication network utilizes *packet*-based communication. Winbladh's uses a GSM network for communication that is not necessarily packet based ("GSM" network, col. 7, lines 3-8; col. 3, lines 50-52). Nonetheless, Winbladh disclosed that his system is not restricted to any specific wireless telephone system such as GSM and that other telecommunications systems can be used within the system (Col 3, lines 38-48). Thus, one of ordinary skill in the art would have been motivated to seek out and use other known wireless telephone systems within Winbladh's system. One widely known wireless telephone system that utilizes packet-based communication is GPRS. The use of GPRS in the wireless telephone environment was widely known in the art at the time of invention, as evidenced by at least by Lager and Applicant's admitted prior art (Specification pg 1). Further the inclusion of a GPRS system, including a GPRS attach within a GSM network was well known, as evidenced by Lager. In a similar art, Lager discloses a GSM system that allows a mobile device to set up a packet based session with a network service (Col 1, lines 17-22), including a means for allowing the mobile device to attach to the network, wherein the system uses a GPRS attach (col. 3, lines 41-56; col. 7, line 64 – col. 8, line 30). Given this knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of incorporating the GPRS into the GSM system taught by Winbladh, because GPRS provides effective use of scarce resources (see Lager, col. 1, lines 22-26). Therefore, it would have been obvious to incorporate the GPRS into the GSM system taught by Winbladh.

In considering claim 2, Winbladh further discloses that the message service is SMS ("SMS," col. 7, line 7).

In considering claim 3, Winbladh further discloses that the first packet data network address is an IP address (col. 7, lines 4-5, 61-62, wherein the server is an "Internet GSM Smart Access Server" and thus uses an IP address).

In considering claim 4, Winbladh further discloses that the application performs the act of identifying the mobile communication station to the packet data service part of the digital radio communication network, if the mobile communication station is not identified to that service (col. 8, lines 23-33, wherein upon start-up at the beginning of a session, the mobile station software sends the its number and a password to the server).

In considering claims 6, 21, and 30, Winbladh discloses the claimed activation step of sending a request from the application to the network to activate a packet data service for the mobile communication station if the station does not have such a packet data service activated (col. 8, lines 23-34). However, Winbladh does not disclose the claimed steps of allocating a temporary network address as part of the activation step to the mobile communication station, wherein the temporary network address becomes the address used by the station for the station. That is because Winbladh remains silent regarding how the address is allocated to the mobile communication station. Nonetheless, the GPRS system taught by Lager actually uses a temporary address assignment scheme. See Lager, col. 3, lines 46-57; col. 8, lines 6-30. It is advantageous to use temporary addresses for mobile devices in a GSM network, because temporary addressing allows for a larger number of systems to connect to the network.

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Therefore, it would have been obvious to use the temporary address assignment scheme taught by Lager to improve the scalability of the system taught by Winbladh.

In considering claims 7 and 22, Lager further teaches using GPRS Packet Data Protocol Context activation as the activation request (col. 3, lines 58-65; col. 6, lines 30-35; col. 8, lines 6-20).

In considering claims 8 and 23, Lager further discloses that the temporary network address is an IP address (col. 8, lines 6-20).

In considering claim 9, Winbladh further discloses that the application performs:

Examining an activation code present in the message received by the mobile communication station (col. 8, lines 55-56, "activation code [is] sent from the server 11 via an SMS"); and

Performing said act of identifying the mobile communication station to the radio communication network only if an appropriate activation was found in the message during the examining act (col. 8, lines 62-65, "manual insertion of the obtained code via the activation window activates the communications software 46 for the possibility of sending and receiving e-mail," or col. 9, lines 1-3, wherein activation is automatic).

In considering claim 10, Winbladh further discloses that the application performs:

Examining a service indication field (e.g. prefix Col 7, lines 37-60). The claimed service field is analogous to Winbladh's prefix and claimed message describing a service that is about be initiated is analogous to Winbladh's commands displayed the user and

Presenting a message to a user of the mobile communication station the message being based on the content of the service indication field and describing the service that will be initiated (commands displayed the user e.g. Get Now col. 7, lines 37-60);

In considering claim 11, Winbladh further discloses that the message is a text message (e.g. Get Now col. 7, lines 37-60).

In considering claim 12, Winbladh further discloses that the application further performs the acts of:

Waiting for a reply to the presented message from the user of the mobile communication station (col. 8, lines 54-55, waiting for the user to enter the code); and

Continuing with, or aborting, said act of identifying the mobile communication station to the digital radio communication network in dependence on the reply to the presented message (col. 8, lines 56-57, wherein registration is confirmed if the correct code is entered).

In considering claim 13, Winbladh further discloses that the reply comprises an accept or deny reply (i.e. correct confirmation is an accept reply, and incorrect confirmation is a deny reply).

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In considering claim 14, Lager further discloses the claimed ciphering step (col. 6, lines 10-20). It would have been obvious to include this in the system taught by Winbladh and Lager, in order to improve the security of the system.

In considering claim 15, Lager further discloses that the identification number associated with the mobile station is a MS-ISDN number (col. 3, lines 21-22).

In considering claim 16, Winbladh discloses a system at a mobile communication station ("MS unit 20" coupled to "PC 22") for facilitating immediate transfer of packet data from a network server ("server 11") to a mobile communication station over a digital radio communication network ("GSM" network), including:

First receiving means for receiving a message from a message service provided by the digital radio communication network, the message including a first data network address of said network server ("SMS [message] is sent to the MS unit 20, "col. 7, lines 6-8; wherein the "SMS message is comprised of... a field 'DSG address (Data SMS Gateway Address)' containing the address and/or telephone number of the server 11 in which the intended e-mail has been stored," col. 7, lines 7-8, 32-35);

Extracting means for extracting the first data network address from the message (col. 7, lines 58-61, "the communications software 46 reads the agent-part 48 of SMS and... calls the number in the 'DSG address,'" wherein the "DSG" address is the address of the server, col. 7, lines 31-35); and

Packet data protocol means for establishing a data protocol session ("session") between said mobile communication station and said network server using said first packet data network address (col. 7, lines 61-62, "calls the number in the 'DSG address' 47 (start of a session)"), and for receiving packet data from the network server addressed to a second packet data network address, which second packet data network address is allocated to the mobile communication station (col. 8, lines 53-61, wherein during the session, e-mails and other information are sent to the mobile station, which necessarily has a packet data network address since it is part of the packet data network).

However, Winbladh failed to specifically recite the digital radio communication network utilizes *packet*-based communication. Winbladh's uses a GSM network for communication that is not necessarily packet based ("GSM" network, col. 7, lines 3-8; col. 3, lines 50-52).

Nonetheless, Winbladh disclosed that his system is not restricted to any specific wireless telephone system such as GSM and that other telecommunications systems can be used within the system (Col 3, lines 38-48). Thus, one of ordinary skill in the art would have been motivated to seek out and use other known wireless telephone systems within Winbladh's system. One widely known wireless telephone system that utilizes packet-based communication is GPRS. The use of GPRS in the wireless telephone environment was widely known in the art at the time of invention, as evidenced by at least by Lager and Applicant's admitted prior art (Specification pg 1). Further the inclusion of a GPRS system, including a GPRS attach within a GSM network was well known, as evidenced by Lager. In a similar art, Lager discloses a GSM system that allows a mobile device to set up a packet based session with a network service (Col 1, lines 17-22), including a means for allowing the mobile device to attach to the network, wherein the

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system uses a GPRS attach (col. 3, lines 41-56; col. 7, line 64 – col. 8, line 30). Given this knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of incorporating the GPRS into the GSM system taught by Winbladh, because GPRS provides more effective use of scarce resources (see Lager, col. 1, lines 22-26). Therefore, it would have been obvious to incorporate the GPRS into the GSM system taught by Winbladh.

In considering claim 17, Winbladh further discloses that the message service is SMS (“SMS,” col. 7, line 7).

In considering claim 18, Winbladh further discloses that the first packet data network address is an IP address (col. 7, lines 4-5, 61-62, wherein the server is an “Internet GSM Smart Access Server” and thus uses an IP address).

In considering claim 19, Winbladh further discloses means for identifying the mobile communication station to the packet data service part of the digital radio communication network, if the mobile communication station is not identified to that service (col. 8, lines 23-33, wherein upon start-up at the beginning of a session, the mobile station software sends its number and a password to the server).

In considering claim 24, claim 24 presents a program storage device for performing the same steps as the arrangement of claim 16, and is thus rejected for the same reasons.

In considering claim 25, Winbladh further discloses that the message service is SMS (“SMS,” col. 7, line 7).

In considering claim 27, Winbladh further discloses that the first packet data network address is an IP address (col. 7, lines 4-5, 61-62, wherein the server is an “Internet GSM Smart Access Server” and thus uses an IP address).

In considering claim 28, Winbladh further discloses the program storage device performing the act of causing the mobile communication station to identify itself to the packet data service part of the digital radio communication network, if the mobile communication station is not identified to that service (col. 8, lines 23-33, wherein upon start-up at the beginning of a session, the mobile station software sends its number and a password to the server).

In considering claim 37, Lager disclosed the message comprises a data structure that includes a data field with data that indicates a QoS that the network server wishes that the stand-alone mobile communication station request from the communication network when using the packet data protocol session (Col 2, lines 28-32).

In considering claim 38, Winbladh and Lager disclosed the message comprises a data structure that includes a data field having a port number of the network server to be used by the stand-alone mobile communication station when establishing a TCP/IP connection with the

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network server (i.e. the mobile device connects the server address information which when using TCP/IP would include a port such that client can connect to the server).

In considering claim 39, Winbladh disclosed the message comprises a data structure that includes a data field having a GPRS activation code which distinguishes the message from other retypes of SMS messages (e.g. prefix Col 7, lines 37-60 or activation code Col 8, lines 53-61).

In considering claim 40, Winbladh failed disclosed the use of a ciphering key (see inter alia Col 4, lines 30-34). Furthermore Examiner takes official notice that it widely known in the art to utilize ciphering keys for the transfer of data in order to make the transfer more secure. Thus, it would have been obvious to one of ordinary skill in the art to use ciphering keys for any all transmissions in Winbladh's system in order to ensure the transfers are more secure.

In considering claim 41, Winbladh disclosed a data structure that includes a data field having a service indication which is decoded by the application executing on the stand-alone mobile communication station and which is presented to a user on the stand-alone mobile communication station in the form of a text display message that identifies a service that is about to be initiated, and wherein the method further includes waiting to initiate the packet data protocol session until a user accepts the service identified by the text display message (e.g. a prefix identifies an email can be retrieved and the system waits for the user to select "Get Now" Col 7, lines 37-60).

In considering claims 42-44, Winbladh disclosed the packet data is received at the stand-alone mobile device for display at the stand-alone mobile device (e.g. a user views a downloaded email).

Conclusion

3. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

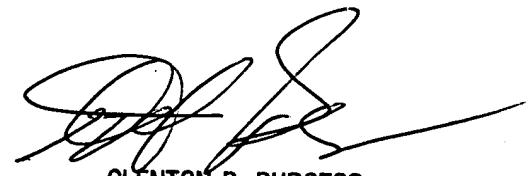
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 7, 2006


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